

REMARKS/ARGUMENTS

In view of the amendments and remarks herein, favorable reconsideration and allowance of this application are respectfully requested. By this Amendment, claims 1-26 have been cancelled. Claims 27-41 have been newly added. Claims 27-41 are pending for further examination.

Claim 10 stands rejected under 35 U.S.C. §112 as being indefinite and under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claim 10 has been cancelled hereby.

Claims 1-18 and 20-26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Navin (U.S. Pat. 5,513,849). Applicant notes that claims 27-31 are apparatus claims most closely corresponding to the original, rejected apparatus claims. Claim 27 now recites, however, *inter alia*, a board consisting of 108 squares, and sets of pieces consisting of six pieces, two of which are equal to one another while the other four are different from one another and from the aforesaid two, wherein one of said four pieces is designated as the main piece and six additional pieces, equal to one another and different from the pieces of said first subset.

Navin does not teach or suggest such a board or set. According to the Office Action, the previous claims were open-ended and thus the claimed board comprising 108 pieces and sets comprising the configuration of pieces could be said to be taught by Navin because those were subsets of the teachings of Navin. Applicant has now presented claims that are close-ended with respect to these particular elements, and thus

Navin can no longer be said to teach these claim elements. Navin teaches a board having 160 squares and a game using conventional chess piece sets. (2:47; 3:17-26). Navin is silent, however, on using a smaller board or less pieces. Thus, one of ordinary skill in the art, when reading Navin, would have been motivated to use the board thereof and the piece configuration thereof, not a different board and a different piece configuration. Further, the game of Navin, traditional chess with more players, is not designed to be played with only a subset of chess pieces, as that is not traditional chess.

For at least this reason, Applicant submits that claim 27 is allowable over the prior art of record. Claims 28-31 should be allowable based at least on their dependency from allowable claim 27.

Claims 25 and 26 stand rejected under 35 U.S.C. 102(b) as being anticipated by Elgen (U.S. Pat. 4,043,559). Claims 25 and 26 have been cancelled.

Claims 1-26 stand rejected under 35 U.S.C. 102(a) as being anticipated by Taurus Games. Applicant notes that the earliest date on the Taurus reference is November 11, 2006. This date is well after the November 14, 2005, filing date of the present application and significantly after the October 23, 2002, priority date of the application. Applicant submits that, barring a showing that the reference predates the priority date of the present application, any rejection based on Taurus is improper. No such showing has yet been made of record in the Office Action or by the reference itself.

Claims 1-18 and 20-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable in view of Smith (D85960) in view of Navin. New claims 27-31 most

closely correspond to the previous apparatus claims. As previously noted, however, Navin does not teach or suggest a board having exactly 108 squares and the set configuration now claimed. While Smith teaches a board having 108 squares, Smith does not teach or suggest a game to be played with this board. Further, combining the teachings of Navin, which discloses a game played with a traditional set of chess pieces using traditional chess rules, with the teachings of Smith would result in a confusing game, since the layout of these pieces would not comport with the layout as explained by Navin. While the Office Action alleges that one of skill in the art would have been motivated (apparently by Navin), to provide four sets of game pieces to play a four player game, one of skill in the art would have had no motivation, absent the present application, to provide the particular set of pieces as claimed by Applicant.

For at least this reason, Applicant submits that claim 27 is allowable over the prior art of record. Claims 28-31 should be allowable based at least on their dependency from allowable claim 27.

Claim 24 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Smith/Navin in view of Aldridge (U.S. Pat. 5,957,455). Claim 24 has been cancelled.

Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Navin in view of Houman (U.S. Pat. 5,908,193). Claim 19 has been cancelled.

Claims 32-39 teach a method of playing a game using a board and set configuration not disclosed in the prior art, and using a method not disclosed in any of the

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prior art. Thus, Applicant submits that claims 32-39 are allowable over the prior art of record.

Claims 40 and 41 are methods of organizing a tournament to play the previously claimed game. Claim 40 recites the novel board and piece configuration of claim 27, and claim 41 recites the novel rules claimed by claim 32, as well as being dependent on claim 40. Thus, Applicant submits that both of these claims are allowable over the prior art of record.

For at least the reasons presented herein, Applicants submit that all of the pending claims clearly and patentably distinguish the prior art of record and are in condition for allowance. Thus, withdrawal of the rejection and passage of this case to issuance at an early date are earnestly solicited.

Should the Examiner have any questions, or deem that any further issues need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

Respectfully submitted,

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